

Docket No. 23915-7319

40. (new) The insert precursor of claim 28 wherein said insert precursor is arcuate.
41 (new) The insert precursor of claim 28 wherein said at least two adjoining portions are axially contiguous.

REMARKS

Claims 23, 24, 28, 30-41 are currently pending. Applicant respectfully requests entry of the above-proposed amendments before the first official action on the subject application, which was filed March 13, 2001 as a Request for Continued Examination. No new matter has been added. The amendments to claims 28 and 35 are made relative to amendments proposed in Applicant's Amendment and Response to Final Office Action dated October 15, 2001. Telephonic communications with the Examiner on March 13, 2002 and March 21, 2002 indicated that the amendments proposed in the October 15, 2001 communication have been entered. Thus, the preliminary amendments include the October 15, 2001 amendments. A clean copy of all currently pending claims is attached.

Claims 38 to 41 are newly added. The addition of these claims does not add new matter. Support for these claims is found within the specification and claims as originally filed.

Further to the remarks in Applicant's last response, Applicant submits the following. The Office Action, mailed April 13, 2001, (Office Action) rejects claims 35-37 under 35 U.S.C. § 102(b) citing U.S. Patent No. 5,076,684 ("the Simpson patent") as prior art. With respect to pending claims 35-37, the office action states that "[b]ecause of the materials typically used for artificial corneas and intralamellar implants, the modulus of elasticity being less than 500 psi is inherent." (Office Action, P.2).

Applicant respectfully disagrees that the subject matter of these claims is anticipated by Simpson. Simpson merely discloses an ophthalmic lens having several concentric zones. This teaching is insufficient to disclose Applicant's invention as presently claimed. Specifically, Simpson does not teach that the disclosed implants are made from material with a modulus of elasticity of less than 500 psi. Simpson provides no teaching about the material in the lens. With respect to independent Claim 35 (amended), which recites that the implant comprises "axially contiguous sections", Simpson discloses only a series of concentric diffractive zones in a Fresnel lens. As can be seen in Figures 1 and 4 of Simpson's patent, the different concentric zones are not axially contiguous.

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Applicant's invention as presently claimed is novel. For these reasons, therefore the 35 U.S.C. §102(b) rejection to claims 35-37 should be withdrawn.

The office action, rejected claims 23, 24, 28, and 30-37 under 35 U.S.C. § 102(e) citing U.S. Patent No. 5,300,118 ("the Silvestrini patent") as prior art. In particular, the office action states that attention should be drawn to Figures 11A and 11B.

Applicant's claimed invention is distinct from the intermeshing rings disclosed in these Figures of Silvestrini at least in that Applicant's claimed insert (as recited in independent claims 23 and 28) is made of "pliable" material. Silvestrini nowhere mentions the modulus of elasticity of the materials used for the inserts. Moreover, to the extent that Silvestrini teaches anything about the pliability, the specification indicates only a stiff material::

"As indicated above FIGS. 5 and 6A show an ICR of the invention which is comprised of a generally circular body member. The ring is comprised of a material *which has sufficient stiffness to maintain its generally circular shape.*" (Silvestrini: Column 2, lines 22-25) (emphasis added)

In contrast, as taught by the subject application, in one aspect of Applicant's invention: "the segments are made up of a number of polymeric layers often with a soft or hydratable polymer on their outer surface." (Spec. Page 11, lines 15-17). The subject application also teaches polymers having low moduli of elasticity. (Spec. Page 13, lines 25-30).

Thus, Silvestrini is insufficient to anticipate Applicant's pending claims, as amended. Accordingly, withdrawal of the rejection is requested.

Applicant's newly added claims emphasize other patentable Applicant's newly added claims emphasize other patentable aspects of the invention. Newly added dependent claims 38 and 40 recite that the shape of the section or insert be arcuate. Newly added dependent claims 39 and 41 recite the axially contiguous requirement for the sections. Neither of the new claims adds new material and support for the claims can be found in the specification and claims as originally filed. These claims depend from independent claims that are novel over the cited art, and are believed to be patentable in and of themselves. For example, claim 38 recites that the section recited in claim 23 be arcuate. Similarly, claim 40 recites that the insert precursor is arcuate. Neither the Simpson reference nor the Silvestrini reference teaches an arcuate shape. Simpson teaches a lens with concentric zones (Simpson: Column 2, lines 42-44); thus the disclosed insert

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is circular, not arcuate; Silvestrini also doesn't teach an arcuate insert; instead, "the ring is comprised of a generally circular body member." (Silvestrini: Column 7, lines 22-24).

Claim 39 recites the sections of claim 23 are axially contiguous. Simpson discloses that the different sections of the lens are concentric and thus not axially contiguous; while the Silvestrini implant is neither elongated nor axially contiguous, rather Silvestrini teaches rings with intermeshing threads. (Silvestrini: Column 9, lines 9-12). Claim 41 provides that the pliable sections of the insert precursor be axially contiguous. Neither of the cited references teach pliable axially contiguous sections.

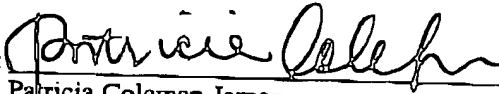
Conclusion

The pending claims, as presently amended, are now in condition for allowance. In the unlikely event that the transmittal letter is separated from this document and/or the Patent Office determines that an extension and/or other relief is required, Applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 50-1189, referencing billing number 23915-7319.

If in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned at (415) 393-2168.

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